

REMARKS

The Office, citing PCT Rule 13.1 contends that the species lack unity of invention because they are not so linked so as to form a single general inventive concept and is requiring an election of species for each of the monomer of the water-soluble units, the water-soluble units, and the units with an LCST.

Applicants have elected, with traverse, Applicants elect, with traverse, the species: (meth)acrylic acid, water-soluble polyurethanes, and polyethers. Claims 1-8, and 16-33 read on these species.

The Election Requirement is respectfully traversed. The Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The Office provides no support for its conclusion that the alternative chemical compounds in the claims are so dissimilar that they fail to meet the requirements of PCT Rule 13.2 for Markush practice. Applicants submit that criteria (A) and (B)(1) are met by the compounds in the present claims and that they are of similar nature as that term is defined in Annex B above.

Applicants further traverse the Restriction Requirement on the ground that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the international application and examined all claims together. Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirement relating to the form and contents of the international application different from or additional to those which are provided for the Patent Cooperation Treaty and the Regulations. In light of PCT Article 27(1) and 37 C.F.R. §145 and §1.499, it is apparent that when the International Preliminary Examination Authority finds no objection based on lack of unity of invention, there is a special burden on the Office to explain why its conclusions are diametrically opposed to those of the International Preliminary Authority, as approved by treaty.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants request that the Office expand its search to the non-elected species when the elected species are found to be allowable.

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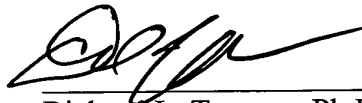
Reply to Office Action of April 6, 2004

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Election of Species Requirement. Withdrawal of the Election of Species Requirement is respectfully requested.

An action on the merits is requested.

Respectfully submitted,

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